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AMERICAN TECHNICAL CERAMICS CORP.

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

PRESIDIO COMPONENTS, INC., Plaintiff, v. AMERICAN TECHNICAL CERAMICS CORP., Defendant.	Case No. 3:08-cv-00335-IEG-NLS **ATC'S REPLY MEMORANDUM OF POINTS AND AUTHORITIES IN FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS** **ORAL ARGUMENT REQUESTED** Hearing Date: August 8, 2008 Hearing Time: 10:00 am Courtroom 1
AMERICAN TECHNICAL CERAMICS CORP., Counter-Claimant, v. PRESIDIO COMPONENTS, INC., Counter-Defendant.	

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ATC prepared its motion for summary judgment of indefiniteness before the Court issued the Claim Construction Order. (ATC filed its motion on the day the Court issued its order.) Accordingly, ATC directed its motion to the indefiniteness of the literal, unconstrued language of the asserted claims. The constructions adopted by the Court do not render ATC's motion moot. Knowing the claim constructions adopted by the Court, Presidio opposes summary judgment of indefiniteness arguing that the claim terms as construed by the Court are definite. Presidio also defends definiteness of two of the claim terms based on their literal language. Accordingly, this reply brief focuses on the indefiniteness of the claims as construed, while responding to all of Presidio's arguments.

I. THE COURT DEFERRED RESOLUTION OF INDEFINITENESS UNTIL AFTER CLAIM CONSTRUCTION

The Court's adoption of certain of ATC's proposed constructions does not preclude ATC from arguing that the literal language of the claims and the adopted constructions are indefinite. The Court specifically "decline[d] to address ATC's indefiniteness argument [at the claim construction stage of the case] … and conclude[d] such analysis would be more appropriate at the summary judgment stage." (Order at 7) ATC and its expert Dr. Dougherty have always maintained that all the asserted claims are indefinite. ATC's claim constructions were offered only as a best approximation if a construction was required to be submitted. (ATC's Claim Constr. Briefs, Dkt. Nos. 51, 54; ATC Br. Ex. 5, Dougherty ¶¶ 34-37, 56, 57, 66, 71, 72, 74)

II. PRESIDIO'S REPLACEMENT EXPERT CANNOT CONTRADICT ADMISSIONS OF ITS EARLIER EXPERT WHO AGREED WITH ATC

Seeking to fabricate an issue of material fact, Presidio simply dropped its previous expert, Dr. Godshalk, because he agreed with ATC's Dr. Dougherty on the indefiniteness of the asserted claims.[1] It switched to a new hired gun, Dr. Gary Ewell, who attempts to substitute contradictory opinions to potentially create a fact issue. It is well established that a declaration of a witness, filed to raise issues of fact to defeat summary judgment, which contradicts his own deposition testimony, is entitled to no weight on summary judgment. *See Sinskey v. Pharmacia Ophtalmics, Inc.*, 982 F.2d 494 (Fed. Cir. 1992). The *Sinskey* Court held that

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[1] This is apparent from ATC's Statement of Undisputed Material Facts (e.g., ¶¶ 7, 11, 14, 20, 26), which Presidio ignored.

> A party cannot create an issue of fact by supplying an affidavit contradicting his prior deposition testimony, without explaining the contradiction or attempting to resolve the disparity. Where, as here, a party has been examined extensively at deposition and then seeks to create an issue of fact through a later, inconsistent declaration, he has the duty to provide a satisfactory explanation for the discrepancy at the time the declaration is filed. To allow him to preclude summary judgment simply by contradicting his own prior statements would seriously impair the utility of *Federal Rule of Civil Procedure 56*. The trial court properly disregarded the declaration in assessing the existence of a genuine issue of fact.

Sinskey, 982 F.2d at 498. Presidio cannot circumvent this principle by doing indirectly what it cannot do directly. It cannot simply have a new expert, who has not yet been deposed, submit a contradictory declaration. Presidio cannot make the admissions made by Dr. Godshalk go away by making him disappear from the case. These statements by Dr. Godshalk are Presidio's admissions, and ATC and the Court are entitled to rely on them. *See Kreppel v. Guttman Breast Diagnostic Institute, Inc.*, 95 Civ. 10830, 1999 U.S. Dist LEXIS 19602 (S.D.N.Y. Dec. 21, 1999) (opinions of an opposing expert, dropped by the opponent from the case, are admissible as adoptive admissions under FRE 801(d)(2)(A)); *Sure-Safe Indus., Inc. v. C&R Pier Mfg.*, 851 F.Supp. 1469, 1473-74 (S.D. Cal. 1993) (denying a motion to withdraw and replace an expert who provided "damaging deposition" testimony).

A. Replacement Expert Agrees With Dr. Dougherty

Even Presidio's switching experts mid-stream does not defeat ATC's clear and convincing showing of indefiniteness of the asserted claims.[2] Dr. Ewell's substantive opinions fall into two categories. None of them defeat summary judgment. **First**, Dr. Ewell, like Dr. Godshalk, agrees with Dr. Dougherty on many material facts. For example, Dr. Ewell repetitively applied Dr. Dougherty's definition of a skilled artisan. Dr. Ewell throughout his declaration examined the claim

[2] Presidio argues that "ATC's burden is more than just clear and convincing evidence." (Pres. Br. 4) Presidio is wrong because the burden on summary judgment is the same as on that issue at trial.

terms through the lens of "one of ordinary skill in the art of designing and manufacturing such multilayer dielectric capacitors, as defined by Dr. J. P. Dougherty…." (Ewell ¶¶ 10, 6, 7, 15, 18, 20)[3] Dr. Ewell also agrees with Dr. Dougherty that a multilayer capacitor produced by sintering is called a monolithic capacitor. Dr. Ewell opined that the claims of the '356 patent are directed to a "standard definition" multilayer capacitor whose "dielectric body … is to be sufficiently sintered, fused, or joined as to constitute a single monolithic structure…." (Ewell ¶ 6)

Dr. Ewell also agreed with Drs. Dougherty and Godshalk that under the principles of physics, any two conductors positioned in an edge-to-edge relationship would form a fringe-effect capacitor of some capacitance value. Dr. Ewell opined that "such 'fringe-effect capacitors', no matter where they are located on the surface of the substantially monolithic body, will have a capacitance…." (Ewell ¶ 15) In addition, Dr. Ewell also agrees that "merely knowing the gap width would not inform a skilled artisan as to what fringe-effect capacitance would result." (ATC Br. at 14 n27) Indeed, Dr. Ewell opined that "it is not the degree of spacing between the two edge-to-edge conductors that is directly significant …." (Ewell ¶ 11) Thus, there is no genuine dispute of material fact between the three experts and the only issue remaining for resolution is a legal conclusion from these undisputed facts.

B. Replacement Expert Rewrote the Claim Construction Order And Did Not Follow Accepted Methodology

Second, Dr. Ewell's "disputes" are not genuine disputes nor are they related to material facts in the case. Dr. Ewell manufactures "disputes" by contradicting the Court's Claim Construction Order. He repeatedly reads into his opinions the language from Presidio's claim constructions already rejected by the Court. For example, he hides behind the rejected "high

[3] While acknowledging the correctness of Dr. Dougherty's definition, Dr. Ewell builds himself up as "sufficiently skilled and experienced in the art of designing and manufacturing reliable Multilayer Capacitors…" (Pres. Br. Ex. D, Ewell ¶ 3) Dr. Ewell's experience as a reliability tester for Government defense projects is irrelevant. Such definition is contrary to the '356 patent since reliability is not a claim limitation and the specification does not even mention reliability or reliability testing. If Dr. Ewell is merely paying lip service to Dr. Dougherty's definition by silently incorporating the unsupported reliability aspect into the definition of a skilled artisan, Dr. Ewell's attempt should be rejected.

frequency performance" to avoid acknowledging that the claim terms at issue, literally and as construed, do not differentiate the alleged invention of the '356 patent from the prior art. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1252 (Fed. Cir. 2008) (a claim is indefinite if it does not "expressly or at least clearly differentiate[] itself from specific prior art"). He also based his analysis of "hexahedron shape" on already rejected major and minor surfaces and even opined that the Court's construction "having six sides" admits of more than six sides. Hence, Dr. Ewell's opinions, based on his "revisions" to the Claim Construction Order, are not a "product of reliable principles and methods" which Dr. Ewell did not apply "reliably to the facts of the case." Fed. R. Evid. 702 (2), (3). Hence, such opinions are inadmissible and should not be considered on summary judgment.

Dr. Ewell's opinions should also be excluded because he defined "definiteness" to mean whether he and others "would understand and have a clear technical picture of what is being claimed and …would be able to understand and arrive at a specific and usable design." (Ewell ¶ 3) Dr. Ewell did not specifically set out to determine whether, in the words of the Federal Circuit, a skilled artisan could "discern the boundaries of the claim"[4] or "could determine whether a particular [apparatus] infringes or not." *Geneva Pharm., Inc. v. Glaxosmithkline PLC*, 349 F.3d 1373, 1384 (Fed. Cir. 2003). In fact, when Dr. Ewell tasked himself with determining if he would be able to design something useful, he did not require that design to be within the scope of the claims (potentially because he could not determine the precise boundaries of that scope). A "clear technical picture" of the claims, is not the same as the boundary of the claim. Accordingly, ATC is entitled to summary judgment that all of the asserted claims are invalid for indefiniteness.

III. PRESIDIO FAILED TO DISPUTE ATC'S EVIDENCE OF INDEFINITENESS

A. Replacement Expert Failed To Present A Workable, Objective Standard For Measuring Purported Degree Of "Monolithicness"

Presidio argues that the literal language of "substantially monolithic dielectric body" is definite (Pres. Br. at 5-7) and that its construction as "largely but wholly without seams" is definite.

[4] *Halliburton*, 514 F.3d at 1249-50.

(Id. at 7-8) ATC addresses these arguments in turn.

Presidio did not raise an issue of fact because Dr. Ewell cannot deny that the term “substantially monolithic” is indefinite. He admitted that “the degree of additional voids and seams will vary from configuration to configuration [so that] the term ‘substantially’ cannot be given a single definition in terms of percent of theoretical density…” (Ewell ¶ 7) The ‘356 specification does not provide guideposts for “substantially monolithic,” nor does it mention percent of theoretical density or its relation to the alleged invention. The ‘356 specification also fails to mention voids in a dielectric body. The Court has already held that the “term ‘substantially monolithic dielectric body’ is not defined in the ‘356 patent and the Court finds the term remains ambiguous even after examination of specifications, embodiments, and other instrinsic evidence.” (Order at 7)

In its Brief, Presidio argues that the term “substantially” is used to “avoid a strict numerical boundary to the specified parameter.” (Pres. Br. at 6) However, its use in claim 1 is misplaced because the ‘356 patent does not disclose any numerical boundary, strict or otherwise. Rather the term “substantially” is applied to an absolute, categorical term “monolithic dielectric body.” There are no degrees of monolithicness. (Dougherty ¶ 27)

Even if monolithicness admitted of degrees, the degree covered by the claim and the degree that is not covered have not been specified either in the asserted claims, the ‘356 specification, or, after the fact, by Dr. Ewell. The best definition Dr. Ewell provided was to vaguely state that

> The use of the phrase “substantially monolithic” then would be understandable to one wanting to differentiate between the amount of voids, gaps, and seams expected in a single “chip” and the amount of voids, gaps, and seams expected in an array of chips sintered into a single, more-complex body. (Ewell ¶ 7; Pres. Br. at 7)

The ‘356 patent does not address this and Dr. Ewell adds nothing concrete to the void of information in the specification. This definition remains subjective and conclusory referring to what would be “expected” without specifying how the specification supports or fosters such expectations and makes them objective. For example, neither the specification, nor Dr. Ewell state how expectations created by different companies and their differing manufacturing conditions can be reconciled with the above explanation.[5] A skilled artisan would not be the "one wanting to differentiate" on this basis because a skilled artisan understands monolithic to be an absolute term not admitting of degree. (Dougherty ¶ 27)

Moreover, this definition is irrelevant here since it sets up a comparison between a single "chip," which is a dielectric body "expected" to have seams from their inclusion of plates, and a "more-complex body." However, the capacitor claimed in claim 1 does not have a "more-complex body" because it simply requires two internal plates within the dielectric body forming a single capacitance (and two contacts on the outside of the dielectric body forming a first fringe-effect capacitance). Therefore, the "more-complex body" comparison has no meaning or relation to the requirements of claim 1.[6]

Notably, Presidio does not even attempt to exemplify how this definition is applicable to classify any particular capacitor configuration. Dr. Ewell did not apply this definition to the capacitors reproduced on page 7 of ATC's Brief--capacitor of Figure 8A of the '356 patent and its modified version. The modified capacitor is the capacitor that Dr. Godshalk admitted was too subjective to determine if it meets the "substantially monolithic" limitation. (ATC Br. Ex. 2, Godshalk Tr. 248:1-8, 22-23) What better proving ground can exist for Dr. Ewell's test than the prime example of the indefiniteness at issue, the modified capacitor of Figure 8A. Dr. Ewell's avoidance of this subjective capacitor is a tacit admission that his test cannot be objectively applied to classify this capacitor. Accordingly, nothing in Presidio's opposition contradicts Drs. Dougherty and Godshalk who both opined that this claim element is not capable of precise, objective definition based on the specification.

This subjective definition is also contrary to the Court's construction of substantially monolithic as "largely but not wholly without seams from the inclusion of plates." Dr. Ewell took the liberty of rewriting the Court's construction to now include "voids [and] gaps [in addition to] seams." (Ewell ¶ 7) In Presidio's view, their varying amounts in different capacitors apparently "render the use of the claim term 'a substantially monolithic dielectric body' appropriate." (Pres. Br. at 6; Ewell ¶ 7) But just a few months ago, even the word "seam" was not acceptable to Presidio. (Presidio Claim Constr. Br., Dkt. No. 53, at 9-10) Now, Presidio and Dr. Ewell do not feel bound by the Court's Claim Construction Order. Hence, his opinions are inadmissible as not based on relevant facts and as not applying the relevant methodology. FRE 702. They are not an obstacle to granting ATC's summary judgment of indefiniteness.

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[5] *Datamize LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005) ("In the absence of a workable objective standard … it is completely dependent on a person's subjective opinion.").

[6] The example of the dielectric body of the capacitor of Figure 2A exposes the self-contradictory nature of this definition. Since this dielectric body has 13 plates and corresponding seams, under Dr. Ewell's classification it would not be monolithic because it is not a single "chip." However, this classification is contradicted by the '356 specification which clearly refers to the dielectric body of Figure 2A as monolithic without mention of any degree:

> FIGS. 2A and 2B illustrate a known multilayer monolithic capacitor structure and its equivalent circuit diagram. (ATC Br. Ex. 1, '356 patent, col. 5:16-17)

The Court's construction of "substantially monolithic," being a reflection of the indefinite claim language, is itself indefinite because it is incapable of being objectively applied to determine whether a particular dielectric body is within or outside the claim scope. The construction of "largely but not wholly without seams from the inclusion of plates" depends upon "the unpredictable vagaries of any one person's opinion." *Datamize*, 417 F.3d at 1350. No standard for comparison is provided. "Largely" is itself a word of degree that is not explained by the '356 patent. None of Dr. Ewell's definitions and tests make its application objective.

Reliability Testing Is Not a Test For Monolithicness

Despite having defined "substantial monolithicness" in terms of "the amount of voids, gaps, and seams," Dr. Ewell's test, surprisingly, is not concerned with determining their amount. Instead, in an effort to make the subjective expectations about "voids, gaps, and seams" less noticeable, Dr. Ewell hypothesizes that a reliability test under conditions undefined in the '356 specification could establish whether a dielectric body is substantially monolithic. Dr. Ewell simply surmises that:

> If the internal gaps, voids, and seams are so small or minor within the parts that the samples remain integral under those conditions and do not fragment or break into pieces, then the body would be considered "substantially monolithic". If the samples did fragment or shatter, than the body would not be considered "substantially monolithic". (Ewell ¶ 8)

Remarkably, Dr. Ewell does not even attempt to directly examine "the internal gaps, voids, and seams." Nor does he explain how to directly distinguish between major and minor internal gaps, voids, and seams. He simply declares, without establishing the causal link or any objective standard, that he considers dielectric bodies which withstand his unspecified testing to be "substantially monolithic."

Presidio is incorrect that "this claim term provides an objective standard for determining what is covered by this claim term." (Pres. Br. at 9) Dr. Ewell's reliability test is not a test for monolithicness; there is no proven relation or causal link between monolithicness and reliability. They are simply two independent characteristics. Dr. Ewell does not prove such causal link or refer to a technical reference establishing it. It is merely assumed. This is not a reliable expert opinion.

Dr. Ewell's test is contrary to the accepted industry wisdom, perhaps best expressed in an unbiased definition of the McGraw-Hill Dictionary, on which the Court relied in the Claim Construction Order. (Order at 8; Dougherty Ex. G) Monolithic capacitor is a capacitor made by the firing or sintering process such as the capacitor of Figure 2A. Once made, it is monolithic. It can acquire or be shown to have other characteristics but they do not change the fact that once made by the sintering process it is called "monolithic."

Even if Dr. Ewell's proposed reliability test is considered, no details for such testing have been provided. In fact, Dr. Ewell proposes that the testing "sequence might involve … electrical testing of the completed substrate and …exposure of the completed substrate to …extremes in temperature exposure and high humidity." (Ewell ¶ 8) He does not specify, or point out in the '356 specification, any electrical parameters to be tested, nor what their values should be to determine if the dielectric body passed or failed the test. Nor does he specify what elements should be placed on "the substrate," *i.e.*, a circuit board. Nor does Dr. Ewell specify the necessary boundaries of the temperature testing or under what electrical conditions it should take place. He does not detail what is meant by a "high humidity" test. In sum, Dr. Ewell's test is not part of the '356 specification nor is it specific by itself.

The entire purpose of the patent law requirement that inventors provide clear boundaries in their claims is to enable others to objectively assess whether their activities fall within the scope of the claim boundaries. The ‘356 specification fails to specifically set the boundaries of the asserted claims and provide an objective test to determine if a product is within or without those boundaries. Dr. Ewell’s misdirected attempts to define degrees of monolithicness and to substitute reliability testing for claim boundaries is the best proof of this--there are no degrees of monolithicness that were standard in the capacitor design art at the time the patent application was filed.[7]

B. Dr. Ewell Cannot Genuinely Dispute That The Adopted Construction Of “In Such Proximity As To From A Determinable Capacitance” Does Not Distinguish the Asserted Claims From the Admitted Prior Art

The indefiniteness of the underlying literal claim language still infects the most reasonable construction of the “sufficiently close” claim element (“in such proximity as to form a determinable capacitance”). Determinable fringe-effect capacitance means what it says--the capacitance between the ends of two contacts of a capacitor positioned in an edge-to-edge relationship is capable of being determined, either calculated by a formula (such as the one in the Walker reference as shown by Dr. Dougherty) or measured physically. It means that one can determine a value of that capacitance, measured in Farads, the units of capacitance. Since the resulting construction simply calls for a determinable capacitance, it does not differentiate between prior art and the alleged invention since both have a determinable capacitance. Therefore, this claim element as construed is indefinite. *Halliburton,* 514 F.3d at 1253.

Dr. Ewell Attempts To Create An Issue Of Fact By Reading Already Rejected Concepts Into The Claim Construction

The only way Presidio attempted to manufacture an issue of fact was by rewriting the Claim Construction Order. The Court construed the term “sufficiently close … to form a first fringe-effect capacitance" to mean "in such proximity as to form a determinable capacitance." (Order at 14) In doing so, the Court rejected Presidio's proposal to construe this element as "forming a capacitance …which affects the high frequency performance of the capacitor as a whole." (*Id*. at 13) The Court held that

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[7] Remarkably, in the whole discussion of the “substantially monolithic” or any other claim element, Dr. Ewell does not refer to the specification even once. “When a word of degree is used the district court must determine whether the patent’s specification provides some standard for measuring that degree.” *Datamize,* 417 F.3d at 1351. Therefore, Dr. Ewell’s declaration, which does not point out specific passages from the specification providing an objective standard for measuring “substantially monolithic,” which Dr. Ewell considers a term of degree, does not follow the Federal Circuit methodology of the indefiniteness analysis and should be disregarded. Shamelessly referring to paragraph 8 of Dr. Ewell’s declaration, Presidio argues that “the specification provides a workable, objective standard to one of ordinary skill in the art (*Id.* [Ewell Decl.] at ¶ 8).” Nowhere in paragraph 8 (nor in any other paragraph), does Dr. Ewell refer or cite the ‘356 specification. Presidio’s blatant attempt to pass off the inadmissible extrinsic declaration of Dr. Ewell as the specification of the ‘356 patent should be rejected.

> The effect on high frequency performance is not mentioned in claim 1 and nowhere in the specification is the effect on high frequency performance explained. There is simply no justification for introducing the language advanced by Presidio into the construction of the disputed claim term. (Order at 14)

This unequivocal rejection apparently had no effect on Presidio which reintroduced the rejected effect on high frequency performance as the meaning of the Court's claim construction. Presidio simply argues that

> In particular, if the first and second contacts are close enough such that the capacitance formed affects the insertion or data loss[8] of the network or array of capacitors, then it is determinable and falls within the scope of this claim term. (Pres. Br. at 10)

Dr. Ewell went even further, essentially rewriting the Court's construction, when he opined that "it is one of the unique advances of this '356 Patent to decrease the normal spacing between such contacts to the point where they form a determinable and useable fringe capacitance that can then be used to adjust high frequency responses of the capacitor array." (Ewell ¶15) The underlined language was rejected by the Court and is not part of its adopted construction. Expert's rewriting of the Court's Claim Construction Order is not a proper way to raise a disputed issue of fact. Dr. Ewell's opinions which are contrary to the accepted methodology for any analysis involving the claims-- the Court's Claim Construction Order--are simply irrelevant and inadmissible under Federal Rule of Evidence 702. They are not a "product of reliable principles and methods" which Dr. Ewell did not apply "reliably to the facts of the case." Fed. R. Evid. 702 (2), (3). Hence, such inadmissible opinions should not be considered on summary judgment.

Dr. Ewell Does Not Provide Any Details About His Required "Detailed Electrical Testing" For Determinable Capacitance

According to Presidio, Dr. Ewell opined that this claim element "provides a workable, objective standard…." (Pres. Br. at 10) Dr. Ewell opined that the test for determinable fringe-effect capacitance is to be done through "detailed electrical testing of samples of each member of a family of similar array designs." (Ewell ¶ 12) Despite requiring that the testing be "detailed," Dr. Ewell only explained it "[i]n general terms, this is how that would happen." (Ewell ¶12) This "general" explanation is no detailed test instruction especially since this test is not spelled out in the '356 specification. First, Dr. Ewell does not define what is "a family of similar array designs," nor does he specify which designs are considered to be "similar," another word of degree. Second, Dr. Ewell then wants one to "electrically measure the properties of the various groups of samples," without specifying what these properties are and how and under what conditions to measure them, what kinds of test substrate are required, etc. (*Id.*)

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[8] At least insertion loss is a parameter associated with frequency performance.

Dr. Ewell did not even wait for the results of this "general" testing to declare the existence of a causal connection between fringe-effect capacitance and the already rejected effect on high-frequency performance (which Dr. Ewell now euphemistically calls "affect on insertion loss, and affect on data loss"):

> One would then electrically measure the properties of the various groups of samples and then associate the change in electrical properties, affect on insertion loss, and affect on data loss, from group to group with the variation in the design of the fringe-effect capacitor. If the capacitor change resulted in a specific change in array electrical properties, then it would be determinable. (*Id.*)

In other words, Dr. Ewell proposes to simply "associate the change … with the variation in the design of the fringe-effect capacitor" regardless of whether the actual data supports such an association. Striving to create an issue of fact, Dr. Ewell simply pre-ordained a conclusion that any change in any properties of the capacitor is caused by the fringe-effect. This is hardly an example of a reliable methodology. It also is irrelevant because it does not determine a value for the fringe-effect capacitor or otherwise make it determinable.

In focusing solely on the fringe-effect, Dr. Ewell ignored the undisputed principles of operation of multilayer capacitors. The more the contacts are extended towards each other, the larger the area of overlap between one of the contacts and the closest internal plate of a different polarity would become. This means that the parallel plate capacitance between one of the contacts and the closest internal plate would be contributing to the capacitance and performance of the capacitor as a whole. (*See, e.g.*, "C_{P2}" in the capacitor shown in Dougherty ¶ 30, which is the parallel plate capacitance formed between the internal plate and the overlapping contact 116.) Such contribution is likely to be much greater than the corresponding fringe-effect capacitance because parallel-plate capacitance is generally much greater than fringe-effect capacitance. (ATC Br. Ex. 2, Godshalk Tr. 99:6-11; Dougherty ¶ 15) Thus, Dr. Ewell's pre-ordained conclusion that fringe-effect capacitance is a root cause of any changes he might observe is wrong because he ignored the other contributing capacitance mechanisms. The Court should reject Dr. Ewell's test as unreliable.[9]

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ATC has made the inability to distinguish the prior art from the alleged point of novelty a principle point of its argument. ATC's Brief urged that "'356 patent does not distinguish the alleged invention shown in Figures 18A and 19A from "Prior Art" Figure 2A, since it does not provide values of the gap widths or the fringe-effect capacitances for either of the figures." (ATC Br. at 11) Presidio did not explain how the redefinition of determinable capacitance or the proposed amorphous test distinguish between the two. Hence, Presidio tacitly admitted that the construction does not differentiate prior art Figure 2A from the alleged invention in Figures 18A and 19A.

Remarkably, Presidio did not even attempt to distinguish the *Halliburton* case which held that that patentee's "failure to distinguish … the invention from the close prior art … is fatal" to the validity of the claim, rendering it indefinite. *Id.* at 1253. The *Halliburton* Court reasoned that "[w]hile patentees are allowed to claim their inventions broadly, they must do so in a way that distinctly identifies the boundaries of their claims." *Id.*

C. "First" fringe-effect capacitance

Dr. Ewell opined that the only way to understand the "first" fringe-effect capacitance is to equate "first" with "a," making the selection completely random:

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[9] Despite proposing an irrelevant and general test for "determinable capacitance," Dr. Ewell does not dispute Dr. Dougherty's conclusion that determinable capacitance can be calculated using, for example, the formula from the Walker reference as Dr. Dougherty demonstrated in his Statement and at the *Markman* hearing. (Dougherty p. 5 n4) Thus, they are in agreement that the capacitance can be determined by such a calculation.

> the word "First" would be readily understood as relating to the first of an arbitrary numbering of multiple fringe-effect capacitors along the surface of the monolithic array of capacitors, the numbering scheme relating to which particular fringe-effect capacitor is designated "one" or "first", which one designated "two" or second, etc. (Ewell ¶11)

Thus, Dr. Ewell confirms that the only reasonable meaning to assign to the word "first" is to simply read it out of this claim and to substitute the article "a." This is the best confirmation that the literal term "first fringe-effect capacitance" has no meaning.[10]

D. "The ceramic body" lacks antecedent basis

Despite its arguments, Presidio still did not identify where in claim 1 the phrase "a ceramic body" appears or has antecedent basis. Presidio, thus, tacitly admits there is no antecedent basis.

Presidio is wrong that "[g]iven that Claim 18 expressly depends from Claim 1, it can only be referring to elements in that claim." (Pres. Br. 13) The statutory requirement for dependent claims is that they "specify a further limitation on the subject matter claimed." 35 U.S.C. §112. Claim 18 can add new elements that were not introduced in claim 1, which would be a "further limitation." *See id.*; *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910-11 (Fed. Cir. 2004) (dependent claim added "a pressure jacket" not recited in the independent claim). The '356 patent discloses multi-body capacitors. Thus, it is entirely plausible that the term "the ceramic body" is referring to another body of such multi-bodied capacitors of the '356 patent. Presidio does not dispute this fact and thus does not raise an issue of fact.

Dr. Ewell opined that the terms "ceramic" and "dielectric" are used interchangeably. (Ewell ¶ 20) This means that they are co-extensive in scope. This admission renders another dependent claim invalid. Claim 16 claims that "[t]he capacitor of claim 1 wherein the dielectric body is ceramic," but using these interchangeable terms does not further limit claim 1 as the dielectric and ceramic, according to Dr. Ewell, mean the same thing. There is a presumption under the doctrine of claim differentiation that a dependent claim has different scope than the independent claim from which it depends. *See Liebel-Flarsheim*, 358 F.3d at 910-11.

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[10] Presidio's reference to a corresponding element in claim 3 is irrelevant because ATC only moved for indefiniteness of "first" fringe effect in claim 1.

E. Hexahedron shape

Despite this claim element being the "dielectric body" as opposed to the capacitor as a whole, Presidio's arguments defending definiteness incorrectly and irrelevantly focus on the capacitor as a whole:

> A capacitor with a hexahedron shape would be understood by one of ordinary skill in the art to refer to a capacitor with at least six sides. (Pres. Br. at 16)

Thus, Presidio failed to oppose ATC's arguments that the dielectric body element is indefinite with any evidence about the dielectric body. As a result, it is undisputed that all the dielectric bodies shown in the figures of the '356 patent have six and only six sides.

Not only did Presidio fail to present relevant evidence about the dielectric body and its properties, but it and Dr. Ewell simply took this opportunity to reargue the rejected claim construction. In the Claim Construction Order, the Court rejected the construction advocated by Presidio based on major and minor sides:

> Where the '356 patent does not teach how to distinguish between a "major" and "minor" surface, the disputed term's use of the term "shape" does not expand the definition of hexahedron to include all objects with six major surfaces. The two dimensional views of dielectric bodies in the embodiments cited by Presidio do not establish an expansion of the claim language. Accordingly, Presidio's proposed construction is rejected. (Order at 15)

Despite this rebuke, Presidio continues to defend definiteness based on the existence of "very minor additional sides" (Pres. Br. at 16) and the existence of "more than six major or significant sides." (Ewell ¶ 19) It does not cite to the '356 specification as disclosing any major and minor sides of a dielectric body. These arguments, based on the rejected major and minor surfaces, are inadmissible as not following the accepted meaning of the claims--the Court's Claim Construction Order.[11]

CONCLUSION

For the reasons set forth above and in the moving brief, ATC's motion for summary judgment of indefiniteness of all of the asserted claims 1-5, 16, 18 and 19 of the '356 patent should be granted as a matter of law.

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[11] Presidio's arguments also reveal that the term as construed continues to be indefinite since Presidio argues that a "capacitor with six sides is not inconsistent with a capacitor with at least six sides." ATC disagrees and submits that there are no fact disputes, only a legal conclusion to be drawn.

Dated: July 18, 2008

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, the undersigned, certify and declare that I am over the age of 18 years, employed in the County of New York, State of New York, and am not a party to the above-entitled action.

On July 18, 2008, I filed and served a copy of the following document(s):

ATC'S REPLY MEMORANDUM OF POINTS AND AUTHORITIES IN FURTHER SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INDEFINITENESS

by electronically filing the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

Miles D. Grant, Esq. Grant & Zeko, APC 1331 India Street San Diego, CA 92101	Attorneys for Plaintiff/Counter-Defendant PRESIDIO COMPONENTS, INC. Email: mgrant@grantandzeko.com
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Executed on July 18, 2008, at New York, New York.

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